

This Opinion is Not a
Precedent of the TTAB

Mailed: May 16, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Smith & Loveless, Inc.
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Serial No. 88497482
—

Jeffrey L. Clark of Wood, Phillips, Katz, Clark & Mortimer,
for Smith & Loveless, Inc.

David A. Brookshire, Trademark Examining Attorney, Law Office 114,
Laurie Kaufman, Managing Attorney.

—
Before Taylor, Heasley, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Smith & Loveless, Inc. (“Applicant”) seeks registration on the Principal Register of the composite word-and-design mark shown below for “wet well mounted pumping stations; wastewater pumping stations; sewage pumping stations,” in International Class 7:



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The Trademark Examining Attorney initially refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that it so resembles the mark EVERLASTING, in a typed drawing,² registered on the Principal Register for "valves for controlling the flow of fluids," in International Class 6,³ as to be likely, when used in connection with the goods identified in the application, to cause confusion, to cause mistake, or to deceive. When the refusal was made final, Applicant appealed and requested reconsideration, which was denied.

After the appeal was fully briefed,⁴ the Board remanded the application to the Examining Attorney for consideration of a possible res judicata refusal to register

¹ Application Serial No. 88497482 was filed on July 2, 2019 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant's claim of first use of the mark and first use of the mark in commerce at least as early as June 2, 2015. Applicant describes its mark as consisting of "the word EVERLAST beneath an image of pipes looped in the general shape of the symbol for infinity."

² "Prior to November 2, 2003, 'standard character' drawings were known as 'typed' drawings . . . A typed drawing is the legal equivalent of a standard character mark." *In re Country Oven, Inc.*, 2019 USPQ2d 443903, at *2 n.2 (TTAB 2019) (citing *In re Mighty Leaf Tea*, 601 F.3d 1324, 94 USPQ2d 1257, 1258 n.2 (Fed. Cir. 2010)).

³ The cited Registration No. 524232 issued on April 18, 1950 under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), and was last renewed in 2019.

⁴ Citations in this opinion to the briefs and other docket entries in the current appeal, and in the prior appeal discussed below, refer to TTABVUE, the Board's online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). Specifically, the number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page number(s) of the docket entry where the

based on the Board's decision in an appeal in Applicant's prior Application Serial No. 87617637, in which the Board affirmed a Section 2(d) refusal to register the same mark for the same goods based on the same cited registration. 12 TTABVUE 4. The Examining Attorney subsequently issued an Office Action maintaining the Section 2(d) refusal, and refusing registration on the additional ground of res judicata,⁵ and following Applicant's response,⁶ the Examining Attorney maintained the Section 2(d) refusal and made the res judicata refusal final,⁷ and the appeal was resumed. 14 TTABVUE 1. Applicant was given the opportunity to file a supplemental brief directed to the res judicata refusal, *id.*, but did not do so.⁸ We affirm both refusals to register.

I. The Disposition of Applicant's Prior Application Serial No. 87617637 and the Background of the Current Application

The Examining Attorney assigned to the current application also examined Application Serial No. 87617637 (the "Prior Application"), and issued a final refusal to register under Section 2(d) in the Prior Application based on the same cited

cited materials appear. Applicant's appeal brief appears at 6 TTABVUE and its reply brief appears at 9 TTABVUE. The Examining Attorney's brief appears at 8 TTABVUE.

⁵ July 24, 2021 Office Action at TSDR 1. Citations in this opinion to the application record are to pages in the Trademark Status and Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO").

⁶ January 24, 2022 Response to Office Action at TSDR 2-5.

⁷ March 4, 2022 Final Office Action at TSDR 1.

⁸ "Although we do not have a brief from Applicant addressing the issue of res judicata, we have considered the entire prosecution file. This includes Applicant's response filed [January 24, 2022], which is discussed *infra* and contains Applicant's arguments against the application of res judicata." *In re SolarWindow Techs., Inc.*, 2021 USPQ2d 257, at *3 n.10 (TTAB 2021).

registered EVERLASTING mark. Applicant appealed the final refusal to register (the “Prior Appeal”), and the Board affirmed the refusal in its June 26, 2019 decision (the “Prior Decision”). *In re Smith & Loveless, Inc.*, Serial No. 87617637 (TTAB June 26, 2019).

In the Prior Decision, the Board sustained the Examining Attorney’s objections to certain third-party registrations attached to Applicant’s appeal brief, and to Applicant’s discussion of certain Internet webpages in its brief, because that evidence had not been made of record during prosecution. 10 TTABVUE 2-6 (Serial No. 87617637). The Board noted that the Examining Attorney had advised Applicant during prosecution of the Prior Application that the third-party registrations and Internet webpages had not been properly made of record, and that Applicant had failed to heed the Examining Attorney’s advice regarding how to make that evidence of record. *Id.* at 5-6.

On the merits of the Prior Appeal, the Board concluded that

[t]he marks are very similar, and the goods are integrally related and are both sold by Applicant, and at least one other manufacturer, through overlapping channels of trade. Sophistication of buyers and purchaser care are relevant considerations, but are not controlling on this factual record. We find that confusion is likely as a result of Applicant’s use of the applied-for mark for the goods identified in the application.

Id. at 24 (quotation and quotation marks omitted). Applicant did not appeal the Prior Decision, and the Prior Application became abandoned on September 12, 2019.

Applicant filed the current application on July 2, 2019, less than a week after the Board issued the Prior Decision. In the current appeal, Applicant acknowledges that

in the Prior Decision, the Board “determined that the evidence supporting Applicant’s arguments had not been properly made of record,” 6 TTABVUE 2 n.1 (Serial No. 88497482), and states that the current application “was filed so that full consideration to Applicant’s arguments could be had.” *Id.* In its current appeal brief, Applicant argues that “[a]ll of the registrations and web sites mentioned in the below argument were made of record during the prosecution of this application . . . and consideration of those arguments should be considered for the first time here.” *Id.* at 2-3 n.1.⁹

II. Record on Appeal

The record on the current appeal includes Applicant’s specimen of use,¹⁰ USPTO electronic records regarding the cited registration,¹¹ dictionary definitions of “everlasting,” “ever,” and “last,”¹² pages from the MERRIAM-WEBSTER and OXFORD online dictionaries showing that there is no entry in those works for the word

⁹ As in the Prior Appeal, Applicant attached the third-party registrations and Internet evidence to its appeal brief. 6 TTABVUE 12-35. “Parties to Board cases occasionally seem to be under the impression that attaching previously-filed evidence to a brief and citing to the attachments, rather than to the original submission is a courtesy or a convenience to the Board. It is neither.” *In re Michalko*, 110 USPQ2d 1949, 1950 (TTAB 2014). As the Board explained in *Michalko*, doing so is counterproductive because “the entire record is readily available to the panel” and referring to attachments to briefs “requires examination of the attachment and then an attempt to locate the same evidence in the record developed during the prosecution of the application, requiring more time and effort than would have been necessary if citations directly to the prosecution history were provided.” *Id.* at 1950-51.

¹⁰ July 2, 2019 Application at TSDR 3.

¹¹ August 2, 2019 Office Action at TSDR 2-3.

¹² *Id.* at TSDR 6-8; September 3, 2020 Request for Reconsideration at TSDR 9-16.

“everlast,”¹³ pages from Applicant’s website,¹⁴ third-party webpages of sellers of pumping stations and valves,¹⁵ and Applicant’s third-party mark evidence.¹⁶

Applicant claims in its reply brief that “most of the evidence which has been submitted herein was not considered by the Trademark Trial and Appeal Board in the appeal of the prior application,” 9 TTABVUE 2, but the record on the Prior Appeal included the same specimen, the same dictionary definitions of “everlasting,” “ever,” and “last,” the same pages from Applicant’s website, and third-party webpages of sellers of pumping stations and valves. 10 TTABVUE 6-7 (Serial No. 87617637). The primary additions to the current record are Applicant’s “new” third-party mark evidence,¹⁷ and additional third-party webpages of sellers of pumping stations and valves, made of record by the Examining Attorney.¹⁸

III. Analysis of Res Judicata Refusal

“Under the doctrine of res judicata (also frequently referred to as ‘claim preclusion’), ‘a judgment on the merits in a prior suit bars a second suit involving the same parties or their privies based on the same cause of action.’” *SolarWindow*, 2021 USPQ2d 257, at *5 (affirming refusal to register based on res judicata)

¹³ September 3, 2020 Request for Reconsideration at TSDR 2-8.

¹⁴ August 2, 2019 Office Action at TSDR 9-16; January 30, 2020 Response to Office Action at TSDR 25.

¹⁵ August 2, 2019 Office Action at TSDR 17-23; March 4, 2020 Final Office Action at TSDR 2-19.

¹⁶ January 30, 2020 Response to Office Action at TSDR 2-24.

¹⁷ *Id.*

¹⁸ March 4, 2020 Final Office Action at TSDR 2-19.

(quoting *In re Bose Corp.*, 476 F.3d 1331, 81 USPQ2d 1748, 1752 (Fed. Cir. 2007) (internal quotation omitted)). Applicant acknowledges that under *SolarWindow*, res judicata may be applied in ex parte appeals.¹⁹

The relevant procedural facts in *SolarWindow* are very similar to those here. In *SolarWindow*, the applicant applied in 2014 to register the mark POWERCOATINGS for chemicals for use in connection with solar cells, and was refused registration on the ground that the mark was merely descriptive. *Id.* at *2. The applicant appealed that refusal to the Board, and after the Board affirmed and the applicant did not appeal the Board's decision, the application became abandoned in 2016. *Id.*

In 2018, the applicant filed a second application to register the same mark for the same goods and received another mere descriptiveness refusal. The applicant again appealed to the Board. After the filing of the applicant's brief, the examining attorney, who had also examined the first application, secured a remand of the second application to issue a new refusal based on res judicata arising from the Board's prior decision on the first application. *Id.* at *2-3. Following the issuance of the res judicata refusal and the resumption of the appeal, the Board affirmed the res judicata refusal, *id.* at *8-10, finding that "the same applicant, mark, and goods are involved in both the prior and present proceedings and the Prior Decision was a final judgment on the merits, i.e., the mere descriptiveness of the identical proposed mark," *id.* at *9; that "the prerequisites for res judicata have been satisfied," *id.*; and that "there has been

¹⁹ January 24, 2022 Response to Office Action at TSDR 3.

no change of conditions or circumstances so as to justify not applying res judicata based on our Prior Decision.” *Id.* at *10.²⁰

Here, less than a week after the refusal of its first application was affirmed in the Prior Decision, Applicant applied a second time to register the same mark for the same goods and subsequently received what it describes as “the same basis of rejection as in the earlier application,” 6 TTABVUE 3, specifically, a likelihood of confusion with the same registered EVERLASTING mark. Applicant argues that “this appeal involves different facts – facts which were not previously considered,”²¹ but candidly admits that the current application was filed on the heels of the Prior Decision solely to cure the evidentiary defects in the record in the Prior Application. *Id.* at 2 n.1. Applicant confirmed in its response to the Office Action on remand that “in the appeal to the TTAB in the prior case, due to an error in the manner in which evidence supporting Applicant’s arguments was cited, the evidence supporting Applicant’s arguments was not considered,” and that “[t]his application was filed simply to have Applicant’s arguments and supporting evidence considered.”²² The “supporting evidence” that Applicant discusses here was admittedly available when

²⁰ “Prior to *Bose*, in *In re Honeywell Inc.*, 8 USPQ2d 1600 (TTAB 1988), the Board addressed the question of whether a prior final judgment arising out of an ex parte case should have preclusive effect on a future application filed by the same applicant.” *SolarWindow*, 2021 USPQ2d 257, at *7. “The Board found that the applicant in *Honeywell* was not precluded from seeking registration a second time, specifically noting that significant time had passed since the first decision,” and that there had been “changes that were crucial to the functionality refusal to registration of the applicant’s mark.” *Id.* As discussed below, no such changed circumstances exist here.

²¹ January 24, 2022 Response to Office Action at TSDR 4.

²² *Id.* at TSDR 2.

the Prior Application was pending, and Applicant’s position on this appeal is simply that Applicant’s arguments based on this evidence “should be considered for the first time here.” *Id.*

Applicant’s submission into the record of the current application of previously available evidence to cure a defect in the record of the Prior Application does not involve a “change of conditions or circumstances so as to justify not applying res judicata based on our Prior Decision,” *SolarWindow*, 2021 USPQ2d 577, at *10, because “pointing to additional facts or . . . making a more persuasive argument based on those facts does not avoid preclusion from an earlier decision.” *Id.* at *8 (citing *SynQor, Inc. v. Vicor Corp.*, 988 F.3d 1341, 2021 USPQ2d 208, at *12 (Fed. Cir. 2021)). “A losing party does not get a second bite at the apple simply because they can find [] new and arguably more persuasive’ evidence to present in the second proceeding,” *id.* (quoting *SynQor*, 2021 USPQ2d 208, at *12), and here the proffered evidence is not even “new.” “Rather, the losing party must demonstrate a material change in the relevant conditions or circumstances, and we are not persuaded that there have been any such changes since the Prior Decision.” *Id.*

Applicant argues that “there is nothing to suggest that there was bad faith (and in fact there was a mistake, but not bad faith) in what occurred in the prior application,” and that “[e]vidence and arguments were not hidden in order to get a second ‘bite at the apple.’”²³ We find, however, that the reason for Applicant’s failure to make the evidence of record in the Prior Application is irrelevant to the application

²³ January 24, 2022 Response to Office Action at TSDR 3.

of res judicata. “It was incumbent upon Applicant to put its best foot forward by presenting during prosecution of the Prior Application all arguments that it believed could overcome the [likelihood of confusion] refusal,” *id.* at *9, and to properly make of record available evidence to support those arguments. Applicant failed to do so, and cannot relitigate the Section 2(d) refusal based solely on evidence that it possessed but failed to make of record in the Prior Application.

“Considering the record in its entirety, we find that the same applicant, mark, and goods are involved in both the prior and present proceedings and the Prior Decision was a final judgment on the merits” *Id.* at *9-10. “Thus, the prerequisites for res judicata have been satisfied,” and as explained above, “there has been no change of conditions or circumstances so as to justify not applying res judicata based on our Prior Decision.” *Id.* at *10 (citations omitted). “Therefore, res judicata applies in this case and this precludes re-litigation of the issue of” likelihood of confusion under Section 2(d). *Id.*

Our decision to affirm the res judicata refusal to register is sufficient to dispose of this appeal. Nevertheless, because the Federal Circuit has “warned that particular ‘caution is warranted in the application of [claim] preclusion by the PTO, for the purposes of administrative trademark procedures include protecting both the consumer public and the purveyors,” *Bose*, 81 USPQ2d at 1752 (internal quotation omitted), we will also decide the Section 2(d) refusal. In doing so, we will look to the Prior Decision for guidance in determining whether the Examining Attorney has once again shown a likelihood of confusion based on the record on this appeal because the

Prior Decision dealt with the same refusal to register the same mark for the same goods, based on almost identical evidence and arguments as on this appeal.²⁴

IV. Analysis of Section 2(d) Refusal

Section 2(d) of the Trademark Act prohibits registration of a mark that so resembles a registered mark as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Our determination of the likelihood of confusion under Section 2(d) is based on an analysis of all probative facts in the record that are relevant to the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Two key *DuPont* factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the “fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

²⁴ Most of the arguments in Applicant’s current appeal brief, including on the “new” third-party marks, are taken verbatim from Applicant’s appeal brief in the Prior Appeal. By way of example, the first sentence of Applicant’s current appeal brief states that “[t]his brief is in support of the Notice of Appeal filed November 14, 2018,” 6 TTABVUE 2, the filing date of the Prior Appeal.

Applicant devotes a section of its appeal brief to the first factor, 6 TTABVUE 8-9, and makes passing references to the second factor at various places in its appeal brief. *Id.* at 3-5, 10. Applicant also alludes to the fourth *DuPont* factor, the “conditions under which and buyers to whom sales are made, i.e., ‘impulse vs. careful, sophisticated purchasing,’” *DuPont*, 177 USPQ at 567. 6 TTABVUE 6-7, 10.

Applicant devotes much of its appeal brief to the impact of the third-party mark evidence. 6 TTABVUE 3-7, 10-11.²⁵ Applicant does not refer to the applicable sixth *DuPont* factor, the “number and nature of similar marks in use on similar goods,” *DuPont*, 177 USPQ at 567, but the claimed third-party marks may be considered under that factor and, as discussed below, under the first factor. We will begin with an analysis of the impact of the third-party marks on the commercial strength of the cited EVERLASTING mark.

A. The Number and Nature of Similar Marks in Use on Similar Goods

The sixth *DuPont* factor “considers ‘[t]he number and nature of similar marks in use on similar goods.’” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1693 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). This factor potentially affects our analysis of the similarity or dissimilarity of the marks under the first *DuPont* factor because the “purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora

²⁵ Applicant made the same arguments in the Prior Appeal, but the Board did not consider them because they were based on evidence that was not properly made of record. 10 TTABVUE 2-6 (Serial No. 87617637).

of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.” *Id.* (quoting *Palm Bay Imps., Inc. v. Veuve Cliquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (internal quotation and quotation marks omitted)).

Applicant relies primarily on two third-party EVERLAST-formative marks.²⁶ Applicant repeats its arguments from its appeal brief in the Prior Appeal under the identical section heading “MULTIPLE REGISTRATIONS EXIST FOR (A) MARKS CLOSER TO **EVERLASTING** THAN APPLICANT’S MARK, AND (B) THOSE MARKS ARE USED (I) WITH GOODS CLOSER TO ‘VALVES’ THAN APPLICANT’S PUMPING STATIONS AND (II) IN MARKETS WITH LESS SOPHISTICATED CUSTOMERS THAN THOSE WHO PURCHASE APPLICANT’S PUMPING STATIONS.” 6 TTABVue 3. Applicant argues that its mark should register over the cited EVERLASTING mark because the USPTO has issued a registration of “a mark including the [cited] registration’s complete EVERLASTING [sic] mark” in the form of a registration of “**Teksan, everlasting company** (stylized), U.S. Regis. No. 5,420,501 . . .” *Id.* (emphasis supplied by Applicant).

²⁶ On the issue of the commercial weakness of the cited EVERLASTING mark under the sixth *DuPont* factor, “[t]he probative value of third-party trademarks depends entirely upon their usage.” *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1693). These marks are the only marks for which Applicant claims to have shown use. We discuss Applicant’s third-party registration evidence, which goes only to the conceptual weakness of the cited mark, *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *24 (TTAB 2021), in connection with our analysis below of the first *DuPont* factor. *See In re Guild Mortg. Co.*, 2020 USPQ2d 10279, at *3 (TTAB 2020) (holding that it is appropriate to consider evidence regarding the conceptual weakness of the cited mark under the first *DuPont* factor).

Applicant claims that

it is illogical to assert, as does the Office Action, that Applicant's mark . . . used with goods involving pumping is likely to be confused with the '232 EVERLASTING' mark by broadly interpreting that mark to be with goods for "conveying liquids", while at the same time asserting that TEKSAN, EVERLASTING COMPANY will not be confused with EVERLASTING where one is used with, *inter alia*, pumps and the other is used in connection with conveying liquids.

Id. at 4. Applicant asks "[i]f the valves of the [cited] registration extend to anything in the 'conveying liquid' market, as evidenced by the **EVERLASTING** and **TEKSAN**,

EVERLASTING COMPANY marks coexisting, then why cannot the  mark

also coexist, particularly with described goods which are more narrowly defined than

"circulating pumps"? *Id.* at 4. Applicant's appeal brief displays a page from the

website of the owner of this registered mark:

2:50 p.m. January 29, 2020
<http://www.teksan.com.tr/en/pdf/sistem/vanali.pdf>

TEKSAN

M-Bus Controlled Shut-off Valves



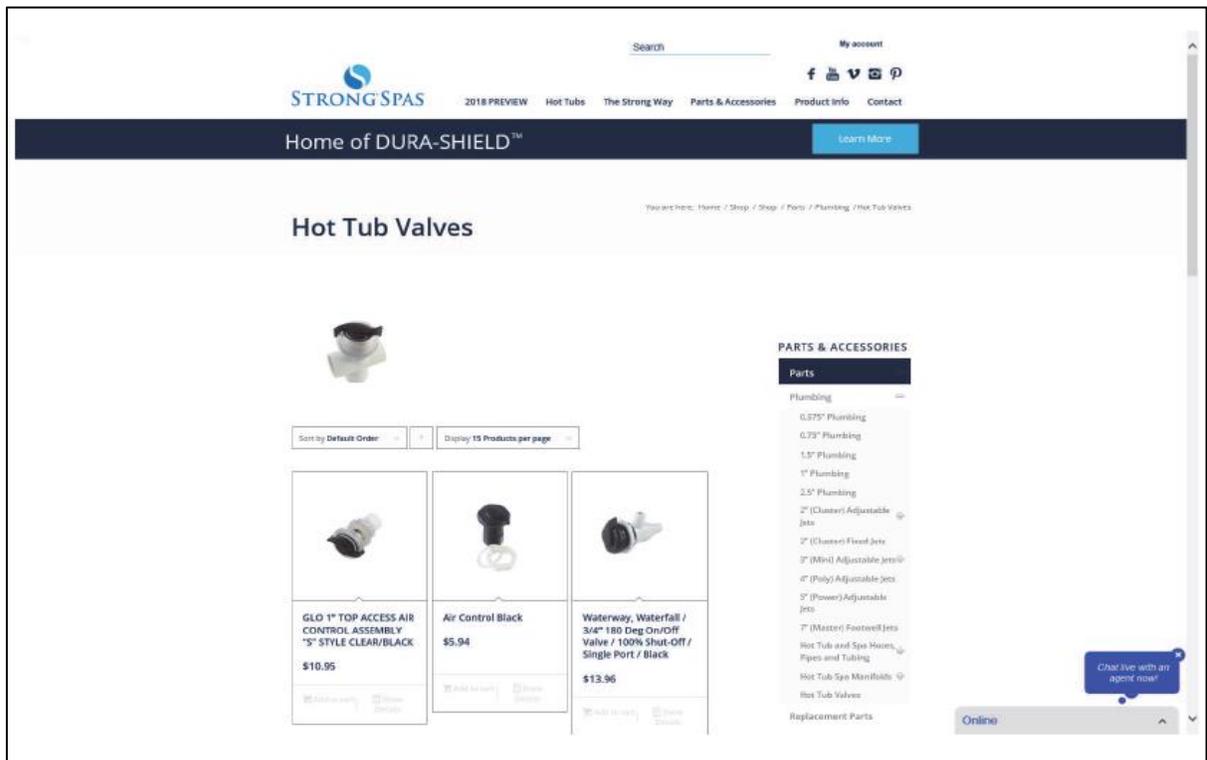
- ▼ MBUS Controlled Shut-off Valves
- ▼ Remote open and close by using MBUS communication
- ▼ Record total volume of water consumed
- ▼ Pulse input from water meter
- ▼ 10 years battery life
- ▼ IP68 protection
- ▼ Sized between DN15 to DN100

Technical Specification

Input: Pulse (magnetically)
Output: Mbus intercommunication protocol
Intercommunication: Compatible with MBUS EN 1434-3
Supply: 3V6 Battery (10 years lifespan)
Cable: 2x0,22 mm multicore
Cable length: 1m
Compatibleness: TR, GT, CH, TH models of Teksan
Protection: IP68

Id. at 6.²⁷

Applicant further argues that its mark should register over the cited EVERLASTING mark because the USPTO has issued a registration of “**EVERLAST SPAS**’ (stylized).” *Id.* at 4. Applicant’s appeal brief also displays a page from the website of the owner of this registration:



Id. at 5.²⁸ Applicant “asserts that the [cited] registration does not cover every mark having some variation of EVERLASTING if used with anything ‘used for conveying liquids.’” *Id.*

²⁷ January 30, 2020 Response to Office Action at TSDR 24.

²⁸ Applicant claims that the “EVERLASTING SPAS and TEKSAN screen shots are from the Web Page Evidence submitted herewith, and made a part of the record during prosecution of this application,” 6 TTABVUE 5 n.2, but the screenshot from the website of StrongSpas does not appear in the record. January 30, 2020 Response to Office Action at TSDR 19-23. The

As noted above, on the issue of the commercial weakness of the cited mark, the probative value of third-party trademarks depends entirely upon their usage. *Tao Licensing*, 125 USPQ2d at 1058. These two webpages do not display the registered marks “Teksan, everlasting company” and EVERLAST, and there is no other record evidence of any third-party use of an EVERLAST(ING)-formative mark. The sixth *DuPont* factor is thus neutral in our analysis of the likelihood of confusion, and does not affect our analysis immediately below of the similarity of the marks under the first *DuPont* factor.

B. Similarity or Dissimilarity of the Marks

The first *DuPont* factor considers “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps.*, 73 USPQ2d at 1691. In the Prior Decision, we found that the “marks are very similar in all means of comparison when they are considered in their entireties,” and that the “first *DuPont* factor thus strongly supports a finding of a likelihood of confusion.” 10 TTABVUE 15 (Serial No. 8761637).

Applicant makes the same arguments here that it made in the Prior Appeal. Applicant argues as follows regarding the impact of the third-party registrations in the record on the similarity of the marks:

There are numerous registrations of marks with EVER+ used with various valves, including EVERLOY (No. 1,702,836), EVERTUFF (No. 3,980,574), and EVERSONG (No. 4,239,237) (see also EVERFLO [No. 3,881,654] and EVERBILT [5,351,058 and 5,387,344] used with a variety

Examining Attorney did not object to this page in his brief, however, so we have considered it.

of pumps) This gives the similarity of the marks in both including “EVER-” somewhat reduced significance when comparing the marks, as that portion is not particularly distinct in the fields of Applicant’s and the cited mark. These registrations are further exemplary illustrations of the reasons Applicant’s mark is not likely to be confused with the cited EVERLASTING registration. Also, an application to register EVERLAST as used with, *inter alia*, watering hoses and nozzles and shutoff valves (Serial No. 86/942,652) has been allowed and a registration will issue upon submission of proof of use (see pages 11-17 of the attached USPTO Evidence).

6 TTABVUE 8 n.3.

Applicant’s third-party registration evidence “may bear on conceptual weakness if a term is commonly registered for similar goods or services.” *Tao Licensing*, 125 USPQ2d at 1057. Like dictionary definitions, third-party registrations may be relevant “to prove that some segment of the [marks] has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015) (internal quotation marks omitted). *See also Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015).

Applicant made of record copies of the certificates of registration of the following marks:²⁹

²⁹ Applicant also made of record a copy of the certificate of registration of Registration No. 1745456 of the mark EVERLAST for “general purpose valve lubricant/sealant for industrial uses such as oilfield services,” January 30, 2020 Response to Office Action at TSDR 4, but admits that it was cancelled in 1999. 6 TTABVUE 8-9. “A cancelled registration is only evidence that the registration issued and it does not carry any of the legal presumptions under Section 7(b) of the Trademark Act.” *In re Info. Builders Inc.*, 2020 USPQ2d 10444, at *6 n.19 (TTAB 2020). Because “dead’ or cancelled registrations have no probative value at

- **Teksan, everlasting company** (stylized) (COMPANY disclaimed) for “alternators; current generators; generators of electricity; emergency power generators; welding machines, electric; truck lifts; air compressors; fuel filters; oil filters; air filters for use as parts of machines or engines; circulating pumps for use as parts of machines, engines or motors; engine mounts other than for land vehicles;”³⁰
- **EVERLAST SPAS** (stylized) (SPAS disclaimed) for “contained spas in the nature of freestanding heated pools and whirlpools with filters, heaters and pumps all sold as a unit;”³¹
- **EVERLOY** for “parts for machine tools; namely, metal and ceramic spray nozzles for use with industrial process machinery; carbide cutting tools for use with machines for wood or metal cutting, forming or shaping; wear and impact-resistant machine tools for use with industrial process machinery; namely, dies, plugs, punches, lathe centers, work rests, guide bushings, shear knives and slitters, rolls for rolling metals, anvils, liners, plungers; valves, seal rings, precision balls; bending tools, crushers and spikes; polishing disks; boring bars;”³²
- **EVERTUFF** for “non-metal rigid pipes, rigid plastic pipes, pipe fitting solvent cements, non-metal pipe fittings, namely, 90-degree ells, side outlet ells, 90-degree reducing ells, [sprinkler head 90-degree ells,] 45-degree ells, 45-degree street ells, 22 1/2-degree ells, 22 1/2-degree street ells, tees, reducing tees, ells, reducing ells, wyes, reducing wyes, couplings, reducing couplings, crosses, reducing crosses, street ells, bushings, unions, flanges, adapters, namely, male, female and transition adapters” and “plastic

all,” *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1264 (TTAB 2011), we have given this registration no consideration and have not included it in the list of the third-party registrations. The Examining Attorney describes the other third-party registrations as “active,” 8 TTABVUE 11, so we will assume that they are subsisting. As noted above, Applicant also made of record USPTO electronic records of a pending application to register EVERLAST for various goods. January 30, 2020 Response to Office Action at TSDR 12-18. The application has no probative value regarding the conceptual weakness of the cited mark because “pending applications are evidence only that the applications were filed on a certain date; they are not evidence of use of the marks.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1745 (TTAB 2018), *aff’d*, 777 F. App’x 516 (Fed. Cir. 2019) (citations omitted).

³⁰ January 30, 2020 Response to Office Action at TSDR 2.

³¹ *Id.* at TSDR 3.

³² *Id.* at TSDR 5.

manually-operated valves, plastic manually-operated check valves and plastic manually-operated drain valves;”³³

- **EVERSONG** (stylized) for “parts of hydraulic machines, motors and engines, namely, gate valves, valve adapters, and flanges; hydraulic controls for machines, motors and engines; hydraulic pumps; hydraulic turbines;”³⁴
- **EVERFLO** for “electric pumps;”³⁵ and
- **EVERBILT** for “pressure switches for well pumps; thermocouples; thermostats; thermostats for water heaters” and “condensate removal pumps; jet pumps for water wells; pool cover pumps for the removal of water; sewage pumps and component basin sold as a unit; submersible pumps; sump pump and component basin sold as a unit; utility pumps, namely, electric pumps.”³⁶

The common element of Applicant’s mark EVERLAST and design and the cited standard-character mark EVERLASTING is not merely the four-letter “EVER-” prefix. As we found in the Prior Decision, the “word EVERLAST in Applicant’s mark differs from the cited mark EVERLASTING only by the absence in Applicant’s mark of the -ING suffix in the cited mark.” 10 TTABVUE 10 (Serial No. 87617637). Here, as in the Prior Appeal, Applicant concedes what it calls “the EVERLAST- similarity.” 6 TTABVUE 8 (Serial No. 88497482). The marks EVERLOY, EVERTUFF, EVERSONG, EVERFLO, and EVERBILT have little or no probative value on the conceptual weakness of the cited mark, regardless of the goods for which they are registered, because they do not contain the EVERLAST- element that is common to

³³ *Id.* at TSDR 6.

³⁴ *Id.* at TSDR 7.

³⁵ *Id.* at TSDR 8.

³⁶ *Id.* at TSDR 9-11. There are two registrations of this mark owned by the same entity. The second registration covers a variety of goods in addition to those listed above.

the involved marks. *See, e.g., Inn at St. John's*, 126 USPQ2d at 1746 (discussing limited probative value of third-party registrations of marks containing differing terms from those in the involved marks, even when used for identical services).

The two subsisting registered marks containing EVERLAST- are “Teksan, everlasting company” and EVERLAST SPAS (stylized). They too have limited probative value. The first mark is dominated by the house mark Teksan.³⁷ The word “everlasting” in the mark modifies “company,” and connotes that the Teksan company, not the goods for which the mark is registered, will last forever. The registration also does not cover either the goods in the application or the goods in the cited registration.

The mark EVERLAST SPAS (stylized) is more similar to Applicant’s mark, but it covers goods identified as “freestanding heated pools and whirlpools with filters, heaters and pumps all sold as a unit,”³⁸ which have not been shown by Applicant to be similar to pumping stations or valves.

Collectively, the subsisting third-party registrations have very little, if any, probative value regarding the conceptual weakness of the cited mark, or the common element EVERLAST-, in the context of the relevant goods. Applicant’s handful of “third-party registrations of varying probative value . . . is a far cry from the large quantum of evidence of third-party use and registration that was held to be significant” in both *Jack Wolfskin* and *Juice Generation*. *Inn at St. John's*, 126

³⁷ As shown above, only the house mark is displayed on the registrant’s webpage in the record.

³⁸ January 30, 2020 Response to Office Action at TSDR 3.

USPQ2d at 1746.³⁹ Applicant did not show that the cited EVERLASTING mark is currently conceptually weak,⁴⁰ or has been weakened commercially by third-party marks.

Applicant's other arguments in this appeal for dissimilarity of the marks were rejected by the Board in the Prior Decision, 10 TTABVUE 10-15 (Serial No. 87617637), and are equally unpersuasive when repeated verbatim here. For the reasons stated in the Prior Decision, we again find that the word EVERLAST is the dominant portion of Applicant's composite mark, and that when the marks are considered in their entireties, giving greater weight to the dominant word EVERLAST than to the "infinity" design in Applicant's mark, the marks are quite similar in appearance because "a consumer with a fallible memory and a general impression of the cited EVERLASTING mark who encounters Applicant's EVERLAST-dominated mark is unlikely to distinguish the two marks on the basis of the presence of the infinity symbol in Applicant's mark," *id.* at 11; in sound because the "design element in Applicant's mark would not be verbalized and the dominant

³⁹ "[I]n *Juice Generation*, there were at least twenty-six relevant third-party uses or registrations of record . . . and in *Jack Wolfskin*, there were at least fourteen . . ." *In re Morinaga Nyugyo K.K.*, 120 USPQ2d 1738, 1746 n.8 (TTAB 2016) (citations omitted).

⁴⁰ As noted above, the mark was registered on the Principal Register in 1950 based on the registrant's showing of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). The registrant's reliance on Section 2(f) was a concession that the EVERLASTING mark was not inherently distinctive, and thus was conceptually weak, in 1950. *See, e.g., In re GJ & AM, LLC*, 2021 USPQ2d 617, at *33-34 (TTAB 2021). But the USPTO's acceptance of the Section 2(f) claim and registration of the mark on the Principal Register establish that the mark had acquired distinctiveness by 1950. A "mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions, including the presumption that the mark is distinctive," *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006), and the EVERLASTING mark, which has been registered on the Principal Register for more than 70 years, is thus presumed to be distinctive.

word EVERLAST sounds like the first three syllables of EVERLASTING,” *id.*; and in meaning because “EVERLAST is roughly synonymous with EVERLASTING.” *Id.* The record again contains a page from Applicant’s website that touts the “long service life” of its EVERLAST product and states that “**EVERLAST™** is designed to provide you a long, successful pumping life”:

Smith & Loveless Inc.'s above-ground wastewater pumping stations pave the way for end-users to reap the benefits of robust construction, operator-safe maintenance and single-source solutions. The result is efficient pump station performance, long service life and realized savings—verified by decades of successful installations.

S&L's next generation **EVERLAST™** Wet Well Mounted Pump Stations perfectly embody this philosophy. Featuring the top S&L innovations, new looks and enclosures, convenient package options, and leading warranty protection, **EVERLAST™** is designed to provide you a long, successful pumping life.

Series 2000

- Packaged Station
- Sliding Two-Piece Enclosure
- 3/8" (9.5 mm) Baseplate
- Relay Logic Controls

Flows	Up to 1,300 GPM (82 lps)
TDH	Up to 158' (48 m)
Power	1.5 - 50 Hp (1.1 - 37 kW)
Pumps	4" - 6" (100 - 150 mm)

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Here, as in the Prior Decision, we find that the “marks are very similar in all means of comparison when they are considered in their entirety. The first *DuPont* factor thus [again] strongly supports a finding of a likelihood of confusion.” *Id.* at 15.

⁴¹ August 2, 2019 Office Action at TSDR 11.

C. Similarity or Dissimilarity of the Goods and Channels of Trade

The second *DuPont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,” while the third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051-52 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014).

The goods need not be identical, but “need only be related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Evidence of relatedness may include news articles or evidence from computer databases showing that the relevant goods are used together or used by the same purchasers; advertisements showing that the relevant goods are advertised together or sold by the same manufacturer or dealer; or copies of prior use-based registrations of the same mark for both applicant’s goods and the goods listed in the cited registration.

In re Ox Paperboard, LLC, 2020 USPQ2d 10878, at *5 (TTAB 2020) (citing *In re Davia*, 110 USPQ2d 1810, 1817 (TTAB 2014)).

“The Examining Attorney need not prove, and we need not find, similarity as to each product listed in the description of goods. [I]t is sufficient for finding a likelihood of confusion if relatedness is established for any item encompassed by the

identification of goods within a particular class in the application.” *In re St. Julian Wine Co.*, 2020 USPQ2d 10595, *3-4 (TTAB 2020) (quoting *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015)); *see also Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Applicant’s arguments here regarding the dissimilarity of the goods and channels of trade are the same ones that Applicant made in the Prior Appeal. The Board rejected them in the Prior Decision, 10 TTABVUE 15-22 (Serial No. 87617637), and we reject them again here.

Applicant’s core argument here that “[t]he broad scope given to the goods and market of the [cited] registration is unreasonable . . . particularly where the goods themselves (valves and pumping stations for special markets) are so different,” 6 TTABVUE 10 (Serial No. 88497482), was rejected in the Prior Decision because “we must deem the ‘valves for controlling the flow of liquids’ identified in the EVERLASTING registration to encompass valves for pumping stations,” 10 TTABVUE 20 (Serial No. 87617637), and the record showed that a number of companies, including Applicant itself, sold both pumping stations and valves. *Id.* at 17-19. The record here is even stronger on this issue than it was in the Prior Application because it includes not only the record evidence in that case, but also new third-party webpages showing the sale of sewage pumps and valves under the same marks.⁴² Based on the record evidence, and the Board’s long recognition “that the sale of both a finished product and a component part of that product under the same or

⁴² March 4, 2020 Final Office Action at TSDR 2-19.

similar marks may give rise to confusion,” *id.* at 19 (citations omitted), we again find that the “intimate relationship’ between pumping stations and valves could give rise to confusion when . . . someone who has purchased or is considering purchasing an EVERLAST pumping station is exposed to an EVERLASTING valve for those goods, or someone who has purchased an EVERLAST pumping station is considering purchasing an EVERLASTING valve.” *Id.* at 20. “Because the goods are intrinsically (indeed integrally) related and there is record evidence, most importantly from Applicant’s own website, that the goods may be sold under the same marks, the second *DuPont* factor [again] supports a finding of a likelihood of confusion.” *Id.* at 22.

With respect to the third *DuPont* factor, the record again “shows that the normal trade channels for the goods overlap,” *id.*, and that “the goods identified in applicant’s application and in [the cited] registration would be encountered by the same purchasers on the same manufacturer and/or supplier websites.” *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009). “This overlap in trade channels supports a finding, under the third *du Pont* factor, that a likelihood of confusion exists.” *Id.*

D. Purchasing Conditions and Consumer Sophistication

Under the fourth *DuPont* factor, the “conditions under which and buyers to whom sales are made, i.e. ‘impulse’ vs. careful sophisticated purchasing,” *DuPont*, 177 USPQ at 567, Applicant again argues in this case that “it should be recognized that the goods with which Applicant is using its [mark] and applying to register that mark

are of a type in which a high degree of care is used when purchasing such products.” 6 TTABVUE 6 (Serial No. 88497482). Specifically, Applicant again argues that pumping stations are complicated products, “and are relatively expensive and thus the type of goods bought in a sophisticated market in which the customers pay particular attention and are particularly knowledgeable about suppliers of such goods.” *Id.*

Here, as in the Prior Appeal, these claims are based solely on argument of counsel, not evidence, but here, as in the Prior Decision, “we will assume, based on the inherent nature of the goods as shown and described in the record, that both pumping stations and valves for pumping stations ‘are somewhat expensive and that some care would be taken in purchasing the goods.’” 10 TTABVUE 23 (Serial No. 87617637) (quoting *Davey Prods.*, 92 USPQ2d at 1204). In the Prior Decision, however, we noted that “[e]ven though the goods are somewhat expensive and would be purchased with a heightened degree of care, the fourth *DuPont* factor only slightly supports a finding that confusion is not likely.” *Id.* at 24. On this appeal, Applicant has given us no reason to reach a different conclusion on this factor.

E. Summary and Conclusion on Section 2(d) Refusal

Applicant’s third-party mark evidence is insufficient to show that the cited mark is either commercially or conceptually weak, or is entitled only to a narrow scope of protection. Here, as in the Prior Decision, we find that the “marks are very similar, and the goods are integrally related and are both sold by Applicant, and . . . other manufacturer[s], through overlapping channels of trade,” *id.* at 24, and that the

sophistication of the purchasers of the involved goods does not outweigh the evidence on the other *DuPont* factors. We again “find that confusion is likely as a result of Applicant’s use of the applied-for mark for the goods identified in the application.” *Id.*

Decision: The refusals to register on the grounds of res judicata and likelihood of confusion are affirmed.